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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,805	03/28/2006	Youhei Sakamoto	278542005000	9375

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MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

EXAMINER
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SHEDRICK, CHARLES TERRELL

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,805	<b>Applicant(s)</b> SAKAMOTO ET AL.	
	<b>Examiner</b> CHARLES SHEDRICK	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/10/09 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 4/10/09 have been fully considered but they are not persuasive.

Regarding independent claim 1, Applicant indicates that as an exemplary advantage of embodiments of the present invention, an auto-power-off unit causes a timer to operate during execution of a non-telephone function (e.g., music ), and automatically stops the execution of the non-telephone function (e.g., music) when the timer indicates an elapse of a predetermined time period. A reset unit rests the timer to an initial state each time a predetermined operation relating to the telephone function (e.g., a phone call) is executed. Thus, wasteful battery consumption is avoided.

Tagawa states that "in case of stopping reproduction of music (e.g., a non telephone function) on receiving a call (e.g., a telephone function), music reproduction is resumed at the position run back (e.g., resetting) for a predetermined time period from that of receiving a call, or from the beginning of the music." (See column 3, lines 9-23). Tagawa further states, "[a]lso, the mobile phone may further comprise a unit operable to count elapsed time after a call arrives, in which..,

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consumption can be cut down." (See column 3, line 63, to column 4, line 2). (The Examiner further refers to column 12, lines 64, to column 13, line 2, column 13, lines 20- 51, column 16, lines 10-25, and Figs. 13A-14B). In the Final Action, dated December 10, 2008, the Examiner alleges that Tagawa discloses that, in case of stopping reproduction of music upon receiving a call, music reproduction is resumed at the position run back for a predetermined time period from that of receiving a call, or from the beginning of the music. In the Advisory Action, dated March 24, 2009, the Examiner states Tagawa discloses a method of setting the timer to an initial state (i.e., run back). The Examiner goes on to state, "resuming reproduction at a point run back 5 secs would at least read on resetting the timer 5 secs to the initial state prior to the incoming call." However, even assuming arguendo that merely resuming music reproduction at the position run back for a predetermined time period from that of receiving a call is equivalent to resetting the timer to an initial state each time a predetermined operation relating to the telephone function is executed, the "timer" of Tagawa would be operated only in response to a telephone function (i.e., receiving a call). *Thus, Tagawa does not teach or suggest a reset unit operable, if the timer is being operated in response to the execution of the non-telephone function, to reset the timer to an initial state each time a predetermined operation relating to the telephone function is executed.*

However, the Examiner respectfully disagree. It appears that the Applicant is arguing that the timer is only related to the telephone function. The Examiner respectfully submits that one of ordinary skill in the art would recognize that Tagawa teaches that the "unit(s)" operates in conjunction with telephone and non-telephone functions so that music play-back and calls can exist accordingly. Therefore, the Prior art of record would still read on the alleged novelty.

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Independent claim 11, as amended, recites features substantially similar to those described above with respect to claim 1. Therefore, it is respectfully submitted that independent claim 11 is not patentably distinct over Tagawa for at least the foregoing reasons.

Claims 2-3 and 5-10 depend from independent claim 1 and inherit the patentability thereof. Therefore, the pending dependent claims are not patentably distinct over the cited art for at least the reasons presented herein.

Dependent claim 4 stands rejected as being unpatentable over Tagawa in view of Yamedera, and further in view of Yoshinaga (U.S. Patent No. 7,096,045). Claim 4 inherits the patentability of independent claim 1, which is not patentably distinct over Tagawa and Yamedera for the reasons presented above.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3 and 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al. US Patent No.: 6,947,728 B2, hereinafter, "Tagawa" in view of Yamedera et al, US Patent Pub. No.: 2002/0123368, hereinafter, "Yamedera".

Consider **claims 1 and 11**, Tagawa teaches a method and a mobile phone having a non-telephone function, which is a different function from a telephone function, in addition to the telephone function, comprising: a non-telephone unit operable to execute the non-telephone function (e.g., **music reproduction function**)(see at least abstract and at least col. 2 lines 7-10); an unit operable to cause a timer to operate during execution of the non-telephone function (e.g., **the fade out, fade in time, response time, music reproduction time**)( see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1), and automatically stop the execution of the non-telephone function when the timer indicates an elapse of a predetermined time period (e.g., **based on the fade out, fade in time, response time, music reproduction time**)( see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and

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**claim 1**); a telephone unit operable to execute the telephone function(e.g., **incoming call as noted in at least the abstract**); and a reset unit operable, if the timer is being operated in response to the execution of the non-telephone function to reset the timer to an initial state each time a predetermined operation relating to the telephone function is executed (e.g., **as also noted in the above cited sections the unit can reset the timer to the initial state of the track or reset to the where the user was originally listening prior to an incoming call function**)( see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1).

However, Tagawa does not specifically teach a/an auto-power-off unit.

In analogous art Yamedera teaches an auto-power off unit (e.g., **see at least paragraph 100 and figure 16**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tagawa to include a/an auto-power-off unit as taught by Yamedera for the purpose of battery conservation.

Consider **claim 2 and as applied to claim 1**, Tagawa as modified by Yamedera teaches wherein the reset unit resets the timer to the initial state at end of a telephone call(e.g., **as also noted in the above cited sections the unit can reset the timer to the initial state of the track or reset to the where the user was originally listening prior to an incoming call function**)( see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1).

Consider **claim 3 and as applied to claim 2**, Tagawa as modified by Yamedera teaches wherein the telephone unit stops executing the telephone function when receiving a disconnect

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signal via a telephone line at the end of the telephone call (**see cited sections and explanations below with regard to resuming music listening function**), and the reset unit resets the timer to the initial state when the execution of the telephone function is stopped by receiving the disconnect signal(e.g., **as also noted in the above cited sections the unit can reset the timer to the initial state of the track or reset to the where the user was originally listening prior to an incoming call function**)( see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and **figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1**).

Consider **claim 5 and as applied to claim 1**, Tagawa as modified by Yamedera teaches wherein the reset unit further resets the timer to the initial state each time execution of a certain operation relating to the non-telephone unit is started e.g., **as also noted in the above cited sections the unit can reset the timer to the initial state of the track or reset to the where the user was originally listening prior to an incoming call function**)( see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and **figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1**).

Consider **claim 6 and as applied to claim 1**, Tagawa as modified by Yamedera teaches the claimed invention further comprising: an application unit operable to execute an application different from the non-telephone function and the telephone function (**i.e., as noted in the Applicants specs a change of setting or other general functions**)(e.g., see **key inputs and buttons for various functions**)( **col. 8 lines 17-60**), wherein the reset unit further resets the timer to the initial state each time execution of a certain operation relating to the application unit is started (**e.g., the timer is reset based on input functions and settings noted in col. 8 lines**



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**17-60).**

Consider **claim 7 and as applied to claim 1**, Tagawa as modified by Yamedera teaches wherein the reset unit resets the timer to the initial state each time a particular key is pressed by a user (**e.g., the stop key resets a listening tracking and the timing thereof**)( **col. 8 lines 17-60**).

Consider **claim 8 and as applied to claim 1**, Tagawa teaches the claimed invention except further comprising: an alarm unit operable to execute an alarm function in a case when an alarm setting has been made by a user, wherein the reset unit refrains from resetting the timer to the initial state when the alarm setting has been made.

However, in analogous art, Yamedera teaches an alarm unit operable to execute an alarm function in a case when an alarm setting has been made by a user (**paragraph 0100**), wherein the reset unit refrains from resetting the timer to the initial state when the alarm setting has been made (i.e., once the phone is off all functions cease)(**paragraph 0100**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tagawa to include a/an alarm unit as taught by Yamedera for the purpose of battery conservation.

Consider **claim 9 and as applied to claim 1**, Tagawa teaches the claimed invention except further comprising: wherein a unit automatically stops the execution of the non-telephone function (**e.g., based on the fade out, fade in time, response time, music reproduction time**)(**see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1**).

However, Tagawa does not specifically teach an alarm unit operable to execute an alarm function in a case when an alarm setting has been made by a user, wherein a unit automatically

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stops the execution a function (**i.e., any and all functions**) in a case when (i) an auto-power-off setting has been made by the user (**e.g., see paragraph 0100**), or (ii) the alarm setting has been made by the user although the auto-power-off setting has not been made.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tagawa to include a/an alarm unit as taught by Yamedera for the purpose of battery conservation.

Consider **claim 10 and as applied to claim 1**, Tagawa as modified by Yamedera teaches wherein the non-telephone function is any of a digital camera function, an Internet connecting function, a music play function, a radio function, and a TV function (**e.g., see music production as noted in at least abstract and above noted citations**).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al. US Patent No.: 6,947,728 B2, hereinafter, "Tagawa" in view of Yamedera et al, US Patent Pub. No.: 2002/0123368, hereinafter, "Yamedera" and further in view of Yoshinaga, US Patent No.: 7,096,045 B2.

Consider **claim 4 and as applied to claim 1**, Tagawa as modified by Yamedera teaches the claimed invention except wherein the reset unit resets the timer to the initial state when the mobile phone is flipped/slid open or closed.

However, in analogous art, Yoshinaga teaches wherein a reset unit resets the timer to the initial state when the mobile phone is flipped/slid open or closed (**col. 7 lines 35-55**)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tagawa as modified by Yamedera to include a reset unit resets

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the timer to the initial state when the mobile phone is flipped/slid open or closed for the purpose of reducing power consumption as taught by Yoshinaga (**col. 2 lines 15-24**).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHARLES SHEDRICK whose telephone number is (571)272-8621. The examiner can normally be reached on Monday thru Friday 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles Shedrick/  
Examiner, Art Unit 2617

/Lester Kincaid/  
Supervisory Patent Examiner, Art Unit 2617